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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,204	10/16/2003	Daniel Lamarre	13/118	7164

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EXAMINER

CLAYTOR, DEIRDRE RENEE

ART UNIT PAPER NUMBER

1617

DATE MAILED: 06/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/687,204

Applicant(s)

LAMARRE ET AL.

Examiner

Renee Claytor

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-14 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This application claims priority from Provisional Application 60/421900, filed on 10/29/2002 and Provisional Application 60/442769, filed on 1/27/2003. Applicant's priority is acknowledged.

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1 (in part), 2, 3, 4, 13, drawn to a method for the treatment of a mammal infected with Yellow Fever virus, comprising administration of a compound of Formula I, classified in class 514, subclass 312.
- II. Claims 1 (in part), 2, 3, 5, 13, drawn to a method for the treatment of a mammal infected with West Nile virus, comprising administration of a compound of Formula I, classified in class 514, subclass 312.
- III. Claims 1 (in part), 2, 3, 6, 15, drawn to a method for the treatment of a mammal infected with Dengue fever virus, comprising administration of a compound of Formula I, classified in class 514, subclass 312.
- IV. Claims 1 (in part), 2, 3, 7, 13, drawn to a method for the treatment of Japanese Encephalitis virus, comprising administration of a compound of Formula I, classified in class 514, subclass 312.
- V. Claims 1 (in part), 8 and 13, drawn to a method for the treatment of GB virus A or C, comprising administration of a compound of Formula I, classified in class 514, subclass 312.

- VI. Claims 1 (in part), 9 and 13, drawn to a method for the treatment of Hepatitis G virus, comprising administration of a compound of Formula I, classified in class 514, subclass 312.
- VII. Claims 1 (in part), 10 and 13, drawn to a method for the treatment of BVDV, comprising administration of a compound of Formula I, classified in class 514, subclass 312.
- VIII. Claims 1 (in part), 11 and 13, drawn to a method for the treatment of border disease virus, comprising administration of a compound of Formula I, classified in class 514, subclass 312.
- IX. Claims 1 (in part), 12 and 13, drawn to a method for the treatment of Classical Swine Fever Virus, comprising administration of a compound of Formula I, classified in class 514, subclass 312.
- X. Claim 14, drawn to an article of manufacture comprising packaging material containing a composition to inhibit a virus of the *Flaviviridae* family and a label indicating that the composition is used to treat a virus of the *Flaviviridae* family, classified in class 435, subclass 810.

The inventions are distinct, each from the other because of the following reasons:

Inventions I, II, III, IV, V, VI, VII, VIII, and IX are directed to related viruses of the *Flaviviridae* family. The related inventions are distinct if the inventions as claimed do not overlap in scope, i.e., are mutually exclusive; the inventions as claimed are not obvious variants; and the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect. See MPEP §

806.05(j). In the instant case, the different inventions are directed to distinct viruses of the *Flaviviridae* family. The viruses of each group are distinct, for example, the symptoms of Yellow Fever virus may lead to liver failure, the symptoms of West Nile virus may lead to meningitis, the symptoms of Dengue fever may lead to Dengue hemorrhagic fever, and Japanese Encephalitis virus may lead to brain damage and paralysis. The viruses BVDV, border disease virus, and Classical Swine Fever virus are found only in bovine, sheep, and swine, respectively. The differences in symptomology and host of each virus will inherently result in different treatment regimens. Thus, by virtue of the different viruses, symptomology, and host of the virus of Groups I-IX, these related inventions are distinct.

Because these inventions are distinct for the reasons given above and the search required for Groups I-IX is not required for any other of Groups I-IX, restriction for examination purposes as indicated is proper. More specifically, the search for treatment options for Yellow Fever virus will not lead to art on treatment options for West Nile virus, Dengue fever virus, Japanese Encephalitis virus, GB virus A or C, Hepatitis G virus, BVDV, border disease virus, or Classical Swine Fever virus. The searches in non-patent literature databases would be extensive and will not overlap thus presenting a search burden to be searched together. Thus, Groups I-IX have been appropriately restricted on the basis of being both independent or distinct and presenting a search burden on the Examiner if they were to be searched together.

Inventions I-IX and X are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the article of manufacture comprising packaging material contained within which is a composition effective to inhibit a virus of the *Flaviviridae* family and a label indicating that the composition can be used to treat infection by a virus of the *Flaviviridae* family wherein the composition comprises administration of a compound of Formula I can be used to house another composition for administration to treat a host of other diseases, such as bacterial, fungal, parasitic or viral infections. Because these inventions are distinct for the reasons given above, restriction for examination purposes as indicated is proper. Moreover, the searches in non-patent literature databases would be extensive and will not overlap thus presenting a search burden to be searched together.

### **Conclusion to Restriction Requirement**

Applicant is advised the reply to this requirement to be complete must include (i) an election of an invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly

and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Due to the complex nature of the instant restriction requirement, a written restriction requirement was necessitated. See MPEP § 812.01.


#### **Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Renee Claytor whose telephone number is 571-272-8394. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Renee Claytor



**SREENI PADMANABHAN**  
**SUPERVISORY PATENT EXAMINER**